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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1935.

No. 590

THE MANTLE LAMP COMPANY OF AMERICA,

vs.

ALUMINUM PRODUCTS COMPANY.

ON CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF OF APPELLANT.

This case is before this Court on a certificate from the United States Circuit Court of Appeals from the Seventh Circuit. The Mantle Lamp Company of America, the original plaintiff, was the appellant in the Circuit Court of Appeals and is so designated in this Brief.

OPINIONS BELOW.

The opinion of the District Court of the United States is not reported nor included in the certificate. So far as it is relevant to the questions certified by the Circuit Court of Appeals for the Seventh Circuit, the District Court's findings appear on page 2 of the Certificate. The Circuit Court of Appeals for the Seventh Circuit has filed no opinion pending instructions from the Supreme Court.

Of collateral interest in this proceeding is the opinion of the Circuit Court of Appeals for the Sixth Circuit in *The Mantle Lamp Company of America* v. *George H. Bowman Company,* reported in 53 F. (2) 441 (Appendix D); and the opinions of the Circuit Court of Appeals for the Seventh Circuit in *Macomb Manufacturing Company* v. *The Mantle Lamp Company of America;* (Appendix B) and *Monarch Company, Inc. et al.* v. *The Mantle Lamp Company of America,* (Appendix C) reported respectively in 22 F. (2) 93 and 95.

JURISDICTION.

The jurisdiction of the Court to entertain this certificate and proceeding and to decide the questions therein raised, rests upon Section 239 of the Judicial Code as amended by the Act of February 13, 1935 (U. S. Code, Title 28, Section 346).

STATEMENT OF THE CASE.

This is a patent case. It came to the Court of Appeals for the Seventh Judicial Circuit on appeal from the District Court for the Northern District of Illinois, Eastern Division, to reverse a decree dismissing the plaintiff's bill of complaint for want of equity. On this appeal the ques-

tion arose as to applicability of Sections 4917 and 4922 of the Revised Statutes relating to disclaimers. Relevant considerations drawn from the record are set forth in the certificate from said Circuit Court of Appeals on pages 1, 2, 3 and 4 thereof. Broadly, the facts are that appellant's Blair patent in suit, No. 1,435,199, for a Heat-Insulated Receptacle, issued November 14, 1922, had been found invalid by the Circuit Court of Appeals for the Seventh Judicial Circuit in two cases that were heard together. These two cases were *Macomb Mfg. Co.* v. *The Mantle Lamp Company of America* and *Monarch Company, Inc., et al.* v. *The Mantle Lamp Company of America.* The former was an appeal from a decree of the District Court for the Southern District of Illinois and the other an appeal from the District Court for the Northern District of Illinois. Both District Courts held the said Blair patent valid and infringed. The mandates in the *Macomb* case and the *Monarch* case went down to the District Court and a decree was entered therein after denial of Petitions for Rehearing on December 5, 1927.

The present suit was commenced on November 21, 1932 —five years later. It is against a different defendant and on a different record. During the five-year interval, the Appellant sought to bring to trial its previously pending suit on the same patent in the Western District of Missouri against one Cutino. At the instance of said Monarch Company, the prosecution of this suit was enjoined in the District Court for the Northern District of Illinois, Eastern Division. It claimed that the Cutino Company was its customer. Motion for temporary injunction was denied and appeal taken to the United States Circuit Court of Appeals for the Seventh Circuit on October 7, 1928. The District Court was reversed and the issuance of the temporary injunction ordered.

On September 12, 1928, The Mantle Lamp Company of America brought suit on the said Blair patent against George H. Bowman Company in the District Court of the United States for the Northern District of Ohio. That court held the Blair patent invalid and decreed a dismissal of plaintiff's bill of complaint. On appeal to the Circuit Court of Appeals for the Sixth Judicial Circuit reversal was had and the Blair patent held valid as to claim 1, without prejudice to the other claims.

Not all of the claims of the patent in suit were charged to be infringed in the foregoing causes. It is the contention of appellant that the Court's opinion of invalidity for lack of invention in the *Monarch* and *Macomb* cases in the Seventh Circuit related to all that was of substance in the said Blair patent in suit. The Mantle Lamp Company of America has not filed a disclaimer following the decision in the *Macomb* and *Monarch* cases.

QUESTIONS PRESENTED.

The questions presented and upon which the Circuit Court of Appeals desires the instruction and advice of the Supreme Court of the United States are:

> "1. Where certain but not all of the claims of a patent are in suit, and all of the claims in suit are held and decreed to be invalid pursuant to a finding and judgment to that effect of the Circuit Court of Appeals of the circuit, may the owner of the patent maintain a suit afterward brought thereon in the same judicial circuit as that in which the first cause was decided, and against a different defendant not involved in the first suit—the second suit being based on the claims held in the prior suit to be invalid and on other claims of the same patent not previously adjudicated—where the owner of the patent wholly

failed and omitted to file any disclaimer of the claims held in the first suit to be invalid, and where, between entry of decree of invalidity of the claims in the first suit and the bringing of the second suit in the same circuit, reasonable time had elapsed for filing such disclaimer?

2. If question (1) is answered in the affirmative does the intervention of a period of approximately five years between the final judgment in the first suit and the institution in the same circuit of the second suit constitute delay so unreasonable as to bar the second suit for want of disclaimer of the claims which had been held to be invalid?

3. If question (2) is answered affirmatively, may the institution or pendency of other suits in another judicial circuit or circuits after entry of final decree in the first suit, based on claims of the patent so held invalid and on other claims thereof not previously adjudicated to be invalid, excuse the failure to file disclaimer of the claims held invalid prior to instituting the later suit in the same circuit?"

THE STATUTES INVOLVED.

The statutes involved are Section 4917 R. S., 35 U. S. Code 65, and Section 4922 R. S., 35 U. S. Code 71, each relating to the subject matter of disclaimers. These statutes are set forth in full in Appendix E hereto.

INTRODUCTION TO ARGUMENT.

The facts herein distinguish the cases heretofore adjudicated under the disclaimer statutes from the case at bar. The disclaimer statutes have no application to the facts of this record.

Broadly speaking, cases relating to disclaimer after adjudication of invalidity are of three classes. The first type of case, illustrated by the case of *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon, Inc.*, 294 U. S. 477, deals with an effort to broaden a patent claim by disclaiming certain elements therefrom.

The second type of case is where, upon a holding of partial invalidity by a Circuit Court of Appeals, the patentee will be required as a condition precedent to ultimate relief by way of injunction and accounting, and recovery of profits and damages upon claims held valid, to disclaim the claims held invalid. This rule has been adopted in several of the Judicial Circuits and is illustrated by the case of *Hoe & Co.* v. *Goss Printing Press Co.*, 31 Fed. (2) 565.

The third type of case is illustrated by the case of *Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 445, 51 S. Ct. 207 which deals with a situation where a patentee, after adjudication of the invalidity of *some of the claims of his patent and validity of others*, fails to prosecute an appeal from such an adjudication. The question in that case was "whether a patentee to save the life of his patent when one claim thereof has been held invalid by an interlocutory decree, must either appeal from such a decree or promptly file a disclaimer."

It is reasonable to require a patentee in such a case to elect to disclaim or appeal after adjudication of invalidity rather than to take the position of holding out such a claim as valid on the one hand, and yet not attempting to demonstrate it to be valid. Such a position is obviously inconsistent and one requiring an election by the patentee. This and nothing more was the holding of the Supreme Court in the *Ensten* case. Excerpts from the opinion clearly demonstrate this (Pages 457-459):

"When a competent court has declared his pretensions without sufficient foundation, we think good faith and the spirit of the enactment demand that he act with such promptness as the circumstances permit *either to vindicate his position or to relieve the public from further evil effects of his false assertion* • • • *and those provisions were intended to protect only those who by prompt action either seek to overturn adverse ruling or retreat from a false position.*

"He did not choose this course but continued to hold himself out as possessor of the sole right to 'make, use and vend' under the rejected claim for nearly two years, then he abandoned it. *He made no effort promptly to vindicate what he had asserted, nor did he surrender it.* Thus he failed to earn the offered exemption and now he may not complain • • •.

"Certainly in this case where an appeal was taken by the defendants, it would have entailed no unreasonable hardship upon the patent owner promptly to have submitted the legality of the rejected claim for determination by the Appellate Court. The route to that end was obvious, easy, inexpensive. *He deliberately failed to defend his assertion of right by appealing.*" (Emphasis supplied.)

As we view it the gist of that opinion, is that a patentee be required to take a stand one way or the other upon a claim adjudicated invalid within a reasonable time after such adjudication. He should either "vindicate what he has asserted" by making every effort to obtain an ultimate holding of validity of the claim in question, or he should surrender that claim.

Obviously the first two classes of cases are inapplicable since no questions arise herein involving either the broadening of a claim by disclaimer, nor disclaiming in order to enforce a decree.

The *ratio decidendi* of the *Ensten* case is that one against whom a decree of invalidity has been rendered must, in fairness to the public, do one of two things; he must either accept defeat and disclaim, or he must continue to fight for the assertion and protection of the right granted him. Either procedure puts the public on notice and knowledge. The disclaimer, if that be the choice, is publicly of record. Continued litigation, by appeal or otherwise, is likewise of public knowledge. The public is not misled at any time by the continued assertion of a right through the medium of the courts, particularly when, as in this case, there has been continuously litigation pending with respect thereto.

It is appellant's position that continued litigation on the part of appellant brings it within the reasoning of the court in the *Ensten* case, and by analogy makes it applicable.

We have found no case where all, or substantially all, of a patent has been declared to be invalid for lack of invention in which the patentee was required to disclaim all except remaining minutia, nor do we believe such to be the spirit of the enactment.

SUMMARY OF ARGUMENT.

Point I.

All the material and substantial parts of the thing patented having been found to be invalid for lack of invention, there is no necessity for filing a disclaimer.

Winans v. *New York & Erie R. R. Co.*, 62 U. S. (21 How.) 88.

R. S. Sec. 4917 (U. S. C. A. Title 35, Sec. 65).

R. S. Sec. 4922 (U. S. C. A. Title 35, Sec. 71).

Brunswick, Balke, Collender Co. v. *Klumpp*, 131 Fed. 255 (C. C. A. 2).

Robinson on Patents, Secs. 643 and 645.

Point II.

Continuous efforts of a patent owner to vindicate its assertion of validity, after a finding of lack of invention, makes unnecessary the filing of a disclaimer.

Ensten v. *Simon, Ascher & Co.*, 282 U. S. 445.

R. S. Sec. 4917, 35 U. S. C. A. 65.

R. S. Sec. 4922, 35 U. S. C. A. 71.

Point III.

The Act of 1891 creating the Circuit Courts of Appeals contemplated finality of judgments and decrees for each Circuit without thereby binding all other Circuits. This has resulted in diversity of opinion resolvable only in the Supreme Court and has been long recognized by the Supreme Court's practice in reference to patent causes.

Point IV.

A valid disclaimer cannot be made to eliminate elements of a patent for a combination.

Altoona Publix Theatres Inc. v. *American Tri-Ergon, Inc.*, 294 U. S. 477.

Vance v. *Campbell*, 66 U. S. (1 Black) 427.

Gill v. *Wells*, 89 U. S. (22 Wall.) 1.

ARGUMENT.

Point I.

All the material and substantial parts of the thing patented having been found to be invalid for lack of invention, there is no necessity for filing a disclaimer.

Since one of Appellant's contentions is that no substantial part of its patent remained after the finding of invalidity by the Circuit Court of Appeals for the Seventh Circuit, a consideration of the claims of the patent are essential for a determination thereof, we attach hereto a copy of the Patent involved as Appendix "A".

The Blair patent No. 1,435,199 (Appendix A) covers a heat-insulated receptacle of the non-vacuum type and, broadly speaking, its several claims all in apt language included as its main structural features,—

(1) an outer metallic, (non-frangible) jacket;

(2) an inner container either frangible or vitreous;

(3) said container being sealed, bonded to, or pendently supported or sustained in, the jacket;

(4) heat-insulating and shock-absorbing comminuted material disposed between the walls of the jacket and the container.

The narrower features claimed, in various of the claims, included as additional elements, a paper lining substantially co-extensive with the jacket (Claims 2 and 15), a circumferential spun seam uniting parts of the outer jacket (Claim 3), a closure for the mouth of the container sepa-

rated from the inner-wall thereof (Claims 8 and 9), a silver coating on the outside of the inner-container (Claim 16), and vitreous stopper with resilient gasket, or a recessed resilient gasket (Claims 19 and 20).

In the Blair device, including a single walled container and a protective metal jacket, the frangible neck of the container and the metal neck of the jacket are so joined by a bond as to provide a unitary element of the device. This unitary element, wherein glass and metal are bonded together, was absolutely new in the art of non-vacuum, heat-insulated receptacles. Blair's combination of elements permits the production of large, strong, and thermally efficient heat-insulated receptacles that successfully competed with the small and fragile, though thermally efficient, vacuum, commonly called thermos, bottles.

The thermal efficiency of the Blair device, as described in the patentee's specification, is due to the fact that the pendent vitreous (glass) receptacle of the new unitary element is so combined with the other parts as to afford only a single, poor heat conducting path and to the fact that moisture is prevented from entering the space between the container and the jacket, which would destroy its thermal efficiency. The result of Blair's combination is, that equalization of temperatures within and without the receptacle is deferred almost as long as it is in the thermos bottle wherein heat-insulation is obtained by a vacuum.

The Circuit Court of Appeals for the Seventh Circuit in the case of *Macomb Manufacturing Company* v. *The Mantle Lamp Company of America,* (Appendix B) 22 Fed. (2d) 93 said, at page 95:

> "The result obtained by Blair may be a better structure than was ever before produced and yet for the lack of novelty of device or new result produced, it

may have no patentable quality. He has assembled—combined in the ordinary sense—old and well known elements but he has not made an invention."

This opinion was adopted by reference by the court in the case of *Monarch Co. Inc. et al* v. *The Mantle Lamp Company of America,* (Appendix C) 22 Fed. (2d) 95.

The claims not in issue in either of those cases, were 2, 8, 9, 15, 16, 19 and 20. Those particular claims, as indicated above, in addition to the dominant structural features of the invention claimed, add only additional details, such as the paper bag, the outside silvering on the container, a vitreous instead of a cork stopper, the gasket for the stopper, or a stopper separated from the inner-wall of the container by an over-extending flange at its upper end. The additional subject matter of the omitted claims therefore refers in each instance to minutia. While these claims, notwithstanding this, might be valid if the broader, dominant, combinations in the other claims were valid, when it is postulated that the claims in suit are invalid, it follows necessarily that the minutia in the claims not in suit would not impart invention with respect to them, particularly when the court found that only mechanical skill and not inventive genius were used in combining the essential elements of the invention. In its broader aspect, the entire substance of the patent was gone.

As an example: Had the duty devolved upon the Appellant to effectually disclaim after the finding of no invention, in order to avail itself of the benefits of the statute, it would have been necessary for it to disclaim all of the fundamental structural features of the patent, including the outer metallic jacket, the inner frangible or vitreous container, means for sealing, bonding or pendently supporting the container from the jacket at only one point,

and comminuted heat-insulating and shock-absorbing material disposed between the jacket and the container, and to disclaim claims 1, 3, 4, 5, 6, 7, 10, 11, 12, 13, 14, 17, 18, 21, 22, 23 and 24, including all the dominant elements of the invention, and either by qualifying disclaimer or by necessary implication would have been required to disclaim those same elements as to claims 2, 8, 9, 15, 16, 19 and 20. Remaining then as novel features would be as to claim 2, "a lining disposed within said jacket and substantially co-extensive with said jacket; as to claims 8 and 9, a closure (disclaimed) separated from the inner wall of said neck by a heat-insulating air space"; as to claim 15, "a retainer for holding said insulating material in place pending the placing in position of a section of the outer jacket" (the same element as claimed in claim 2); as to claim 16, said container "having an outside coating of silver to render it opaque and reflective of heat rays"; as to claim 19, "a *vitreous* stopper carrying a resilient gasket" and as to claim 20, "a *vitreous* stopper having a recess carrying a resilient gasket."

Appellant would have *then* been permitted to test the validity of the remaining claims, the novel features of which would be only a paper lining, a separated stopper, a silver coating on the outside of the container, or a vitreous stopper with a gasket. The ineffectiveness of such a disclaimer in a combination patent will be discussed under another heading.

It is readily apparent that after the finding by the Circuit Court of Appeals in the foregoing cases no material or substantial part of the thing patented remained which the inventor could truly and justly claim as his own, since, as this court so aptly said in the case of *Altoona Publix Theatres* v. *American Tri-Ergon Corporation, et al,* 294 U. S. 477-492:

> "Upon the filing of disclaimers, the original claims were withdrawn from the protection of the patent laws and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned."

Neither the disclaimer Statutes, which were enacted in the first instance to soften the original harsh common law rule, nor practical equity require a disclaimer under these circumstances.

This court indicated in *Winans* v. *New York and Erie R. R. Co.*, 62 U. S. (21 How.) 88, that disclaimers are not involved "where the disclaimer, to be effectual, would include the whole invention". It is the Appellant's position that the disclaimer sections of the statute do not apply where no "material or substantial part of the thing patented" would remain after disclaimer.

An examination of the opinions appearing in the Appendix to this Brief will disclose that the Circuit Court of Appeals for the Seventh Circuit held the claims of the Blair patent involved void for lack of invention; and that the Circuit Court of Appeals for the Sixth Circuit differed in its judgment on the same question. In respect to the claims of the Blair patent held invalid, there is no question of improperly claiming more than the patentee invented. The sole question in respect to validity is whether the patentee invented anything. The disclaimer statutes relate to the claiming of something in excess of the real invention and if this excess of claim is separable, the defect in the patent may be cured by disclaimer. That the application of the disclaimer statutes is to the situation when an excess over an invention is claimed, is supported by *Robinson on Patents*, Section 643, wherein the author, in discussing disclaimers, states:

"A claim is excessive when it claims any material and substantial act or thing beyond the scope of the real invention of the patentee, or beyond the scope of what he has described in his specification, drawings, or model, as his invention."

And again, in the same section, the author states:

"Whether it exceeds the real invention is determined by ascertaining the precise limits of the idea of means embodied in the invention and inquiring if the allegations of the claim cover any substantial instrument or operation not embraced in this idea."

The same thought is made more positive in Section 645 of Robinson which is quoted below in full.

"An excessive Claim can be amended by a disclaimer only when the Claim as amended would cover a patentable invention. The patentee has no right to any patent whatever unless he has invented something which may lawfully become the subject-matter of a patent, and no mistake of his in coupling with his own production such instruments or operations as give to the described invention its entire patentable character can entitle him to retain the patent for what is truly his, after disclaiming that excess in which the attributes of a patentable invention alone reside. No one, therefore, can be permitted to disclaim, unless he or the alleged inventor from whom he derives his title has performed an inventive act, resulting in some material and substantial part of the thing patented which is so far separable from the excess that the patent can be valid for it, and protect it, after the excess has been disclaimed."

But the sole question as to the validity of the Blair patent is not one of excess or divisibility; rather it is the question of invention. No portion of the patent can be disclaimed without disclaiming the whole patent. Against the contention that the patent is invalid for lack of invention, the patentee has no cure or method to remedy the claims save through litigation to enforce them. In all the litigation over the Blair patent, there has been no contention that Blair claimed more than he invented; the sole contention has been that he invented nothing. There is no divisible claim to cured by disclaimer and no claim which may separately be disclaimed. The question of validity goes to the entire patent. As the Circuit Court of Appeals for the Seventh Circuit said in its opinion in the *Monarch* case, Appendix C, namely,

"We hold the patent invalid".

Under this situation, the disclaimer statutes offer no remedy to the appellant. One cannot by any fractionation disclaim a part of zero. He can contest the postulated premise that his patent is zero.

Point II.

Continuous efforts of a patent owner to vindicate its assertion of validity, after a finding of lack of invention, makes unnecessary the filing of a disclaimer.

This court while repeatedly condemning the practice of endeavoring to enforce claims of a patent found to be valid, by those who refuse to disclaim broader claims found invalid, has impliedly approved the right of a patentee to refuse to dedicate to the public all the substance of his patent by disclaimer, provided he vigorously attempts to vindicate his assertion of validity.

The Circuit Court of Appeals for the Seventh Circuit, in its opinion in the case of *Macomb Manufacturing Company* v. *The Mantle Lamp Company of America,* 22 Fed. (2d) 93, selected three patents urged in defense, although two of them did not even belong in the same art, and from those three patents selected three separate elements (one from each) and combined them in an impossible manner and held that the selection of these elements, and the combining of them involved mechanical skill and not invention.

The Appellant then, as now, asserted that the Circuit Court of Appeals for the Seventh Circuit was not justified in arriving at such conclusion nor in selecting from non-analogous arts the prior patents and ascribing to elements thereof functions that the patentees themselves never contemplated nor claimed, and combining those elements, without showing how such a combination could be made, and then finding that not a flash of genius was required to combine the elements into one unitary structure.

Appellant realizing that all of the substance of its patent was gone, then adopted a course which deceived no one as to its intentions. It was not holding out invalid claims as a threat, while it contemporaneously endeavored to enforce claims found valid, but rather, it began a long, continuous, uphill fight to vindicate its position and hoped to ultimately establish the validity of the dominant structural features of its patent. Necessarily such a course of action received set-backs and rebuffs. Its course of action involved the following:

1. Upon the denial of its petitions for rehearing in the *Macomb Manufacturing Company* and *Monarch Company* cases on December 5, 1927, it proposed to and did endeavor to bring to trial its prior co-pending case entitled *The Mantle Lamp Company of America* v. *The Cutino Com-*

pany, pending in the District Court of the United States for the Western District of Missouri.

On January 3, 1928, the Monarch Company, one of the successful litigants in the cases before that time decided by the Circuit Court of Appeals for the Seventh Circuit filed its bill to enjoin the prosecution of said pending case against The Cutino Company in the District Court of Missouri, alleging The Cutino Company to be its customer.

Preliminary injunction being denied, an appeal to the Circuit Court of Appeals for the Seventh Circuit was successful in preventing a trial of the said *Cutino* case (October 8, 1928), so that then the Eighth Circuit as another forum was closed to the Appellant.

2. Prior to the decision of the Circuit Court of Appeals for the Seventh Circuit ordering the issuance of the preliminary injunction to enjoin the prosecution of the Kansas City case, and on September 12, 1928, the Appellant sought redress in the Sixth Circuit by filing a bill for infringement on the same patent against the Geo. H. Bowman Company (it not being a customer of either the Monarch Company or the Macomb Manufacturing Company), in the District Court of the United States for the Northern District of Ohio.

The Ohio District Court, through comity, followed the Seventh Circuit opinions in the *Macomb Manufacturing Company* and *Monarch Company* cases and again found the patent and claims therein sued upon to be invalid.

3. In spite of the usual persuasiveness of an opinion from another Circuit Court of Appeals, the Appellant prosecuted its appeal to the Circuit Court of Appeals for the Sixth Circuit in the said *Bowman* case. Its position in refusing to accept the invalidity of the Circuit Court of Appeals for the Seventh Circuit as being final, was then

justified in that the Circuit Court of Appeals for the Sixth Circuit found the Blair patent valid and reversed the District Court for the Northern District of Ohio.

The Circuit Court of Appeals for the Sixth Circuit, in considering this appeal, examined the entire records in the *Monarch Company* and *Macomb Manufacturing Company* cases decided by the Seventh Circuit Court of Appeals, not for the purpose of reviewing them as an Appellate tribunal, but presumably in an effort to reconcile the Seventh Circuit Court of Appeals' findings with the evidence then before the Circuit Court of Appeals for the Sixth Circuit, and to promote uniformity of decision between Circuit Courts of Appeal.

The opinion of the Sixth Circuit Court of Appeals (Appendix D), reversing the *Bowman* case and finding the Blair patent valid and infringed, is interesting and instructive in that in a foot note it discusses the evidence in the prior cases (*Macomb* and *Monarch*) and in considering the art which the Circuit Court of Appeals for the Seventh Circuit had selected and combined so as to label the same mechanical skill and not invention, said (445):

> "Even if this were a case where the lack of invention could be spelled out in this way, the patents do not seem to us sufficient for that result."

It justified its opinion of validity by the testimony of two competitors showing their unsuccessful efforts to obtain patentee's results by other means, and said that "this evidence alone goes far towards justifying a different result." (*The Mantle Lamp Company of America* v. *Geo. H. Bowman,* 53 Fed. (2) 441, 445. Appendix D.)

The Circuit Court of Appeals for the Sixth Circuit specifically refrained from passing upon more than one claim

and did so without prejudice to any of the Appellant's rights under any other claim.

4. Although probably unprecedented to file a petition for the writ of certiorari in the United States Supreme Court from a decree of which petitioner was not complaining, Appellant nevertheless, in pursuing its efforts to vindicate its position, did file such petition in the *Bowman* case in the Sixth Circuit, there then being a diversity of opinion between circuits not only as to the applicable law involved but on the specific facts as well.

This petition for the writ of certiorari being denied March 14, 1932 (285 U. S. 545), the petitioner filed its bill in the instant case again in the Seventh Circuit reasserting the validity of the Blair patent and substantially all of the claims adjudicated in the former cases in the Seventh Circuit Court of Appeals. The District Court for the Northern District of Illinois, Eastern Division, in this case, found the patent invalid following the opinions of the Circuit Court of Appeals for the Seventh Circuit in the *Macomb Manufacturing Company* and *Monarch Company* cases, and likewise, because the Appellant had failed to file disclaimers after the findings of invalidity in the cases previously adjudicated in the Seventh Circuit. Since the Circuit Court of Appeals for the Seventh Circuit in the *Macomb* and *Monarch* cases did not find part of the Blair patent valid and other portions thereof invalid, (as for instance,—too broad), but rather, without differentiation as to claims, decisively eliminated the entire patent from further consideration of validity, the Appellant was justified in feeling that, in the court's opinion, "No material or substantial part of the thing patented was truly and justly the patentee's" so as to bring him within the sections of the disclaimer statute, permitting one by com-

pliance therewith to salvage or save the residuum of his patent.

It is the Appellant's position in this regard, that the Appellant has not held the claims of its patent found invalid as a threat over the heads of the public without endeavoring to vindicate its position but rather its course of conduct has been such that the trade generally understood quite thoroughly that it believed its patent valid and would pursue its remedies generally to the extreme in its efforts to maintain that position.

The very fact that the Appellant is before this court on these questions certified from the court that had previously found the Blair patent to be invalid, may indicate that with respect to the validity of the patent the Circuit Court of Appeals for the Seventh Circuit in the instant case has already satisfied itself and that the substantial remaining question involved, is the applicability of the disclaimer statutes under these circumstances involving continuity of effort to substantiate an allegation of validity.

We believe this precise question has not heretofore been passed upon by this court, although the opinion in the leading case of *Ensten* v. *Simon, Ascher & Company,* 282 U. S. 445, suggesting an exception to the general rule leads us now to urge as applicable herein, the doctrine thereof where the court said, page 455:

> "When a competent court has declared his pretensions without sufficient foundation we think good faith and the spirit of enactment demand that he act with *such promptness as the circumstances permit* either to vindicate his position or to relieve the public from further evil effects of his false assertion." (Italics ours.)

The Appellant has acted with such promptness as the circumstances permitted (necessary court delays and modern procedure considered) and should be entitled to the benefit under the exception to the rule already implied by the court.

Long continued practice has permitted seeking adjudications of patents in more than one circuit. Without it, few patent infringement suits would heretofore have been adjudicated by this court, particularly after the establishment of the Circuit Courts of Appeals and the finality of their opinions, (except in cases of diversity of opinion between Circuits), and prior to the enactment of 1925 extending and enlarging the jurisdiction of this Court to all cases.

Apparently a patentee must, in *each* instance, be successful, else he may lose his entire franchise by failure to disclaim, but an infringer loses no right to question and contest validity, no matter how often the patent may previously have been found to be valid. Certainly no such unreasonable rule was contemplated.

There never would be necessity for this Court in the interest of uniformity of decisions between circuits to consider patent infringement cases where the patentee in his case adjudicated first in point of time was unsuccessful, even though he might be successful in establishing validity in a later case in another circuit. The patentee herein did not acquiesce in the first ruling—it aggressively pursued its rights in another forum. Was it unreasonably neglectful or dilatory in failing to disclaim—should it have dedicated all or substantially all of its patent to the public? If that be the proper interpretation of the disclaimer statutes, then the cases hereinafter set forth in which the first

adjudication was against the patentee should never have been considered by this Court.

Expanded Metal Co. v. *Bradford,* 214 U. S. 366, 29 S. Ct. 652.

Diamond Rubber Co. v. *Consolidated Rubber Tire Co.,* 220 U. S. 428, 31 S. Ct. 444.

Dowagiac Manufacturing Co. v. *Minnesota-Moline Plow Co.,* 235 U. S. 641, 35 S. Ct. 221.

Railroad Supply Co. v. *Elyria Iron & Steel Co.,* 244 U. S. 285, 37 S. Ct. 502.

Abercrombie & Fitch Co. v. *Baldwin,* 245 U. S. 198, 38 S. Ct. 104.

T. H. Symington Co. v. *National Malleable Castings Co.,* 250 U. S. 383, 39 S. Ct. 542.

Meccano, Limited v. *John Wanamaker,* 253 U. S. 136, 40 S. Ct. 463.

New York Scaffolding Co. v. *Chain Belt Co.,* 254 U. S. 32, 41 S. Ct. 21.

John E. Thropps Sons-Co. v. *Seiberling,* 264 U. S. 320, 44 S. Ct. 346.

Corona Cord Tire Co. v. *Dovan Chemical Corporation,* 276 U. S. 358, 48 S. Ct. 380.

Saranac Automatic Machine Corp. v. *Wirebounds Patents Co.,* 282 U. S. 704, 51 S. Ct. 232.

Radio Corporation v. *Radio Engineering Laboratories,* 293 U. S. 1, 54 S. Ct. 752.

Disclaimer statutes if construed to penalize a patentee under the circumstances herein arising so as to bar him by reason of his failure to disclaim would be contrary to the spirit of the enactment. As is well known, under the early practice patents invalid in part were invalid *in toto.* The disclaimer statutes were intended to soften this harsh rule. Ample justification for the Appellant in this

position is found in the differences of opinion that exist now between circuits.

The often quoted case of *O'Reilly* v. *Morse,* 56 U. S. (15 How.) 62 (1853) at page 121 suggests that delay was not unreasonable in that case because among other things "differences of opinion in relation to it are found to exist among the judges of this court." If it was an excuse in that case, surely the proved excuse of a difference of opinion between Judges of the Sixth and Seventh Circuits now justifies Appellant's proposition that the passage of time was not unreasonable, inasmuch as Appellant was consistently and with such speed as the courts permitted attempting to establish the validity of the patent, even to the extent of attempting to secure the opinion of the court of last resort, to-wit, this court, in having applied to the Supreme Court for the writ of certiorari from the Sixth Circuit case.

The Court, in the case of *O'Reilly* v. *Morse,* said, p. 121:

> "The law which requires and permits him to disclaim, is not penal but remedial. It is intended for the protection of the patentee as well as the public, and ought not, therefore, to receive a construction that would restrict its operation within narrower limits than its words fairly import. It provides 'that when any patentee shall have in his specification claimed to be the first and original inventor or discoverer of any material or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just claim to the same,'—he must disclaim in order to protect so much of the claim as is legally patented."

As Appellant construes the disclaimer statutes, insofar as judicial determination of an inventor having claimed more than that of which he was the original inventor is concerned, it applies only where a patent has been adjudi-

cated to be partly valid and partly invalid, as for instance too broad, and the valid part may be so separated from the invalid part that after the elimination of the invalid part substance still remains in the patent. The disclaimer sections of the statute are not applicable to the instant situation if it is to be construed as a remedial statute rather than a penal one. To construe it against this Appellant would be to penalize it to a greater extent than if the statute had never been passed. For instance, upon the finding of invalidity, for want of invention, of all the substantial parts of Appellant's patent by the Circuit Court of Appeals, the patent, in so far as that circuit is concerned, would have been entirely invalid. The Appellant, however, would have had the right of adjudication in another circuit, and having done so successfully, would have had the right to seek the intervention of this Court on the writ of certiorari to finally determine the validity or invalidity of its patent without any question of necessity for disclaimer arising and without the intervention of any such defense which might bar its rights in a later suit, so that under those circumstances the statute intended as a remedy becomes a penalty, a weapon instead of a bulwark.

Point III.

The Act of 1891 creating the Circuit Courts of Appeals contemplated finality of judgments and decrees for each Circuit without thereby binding all other Circuits. This has resulted in diversity of opinion resolvable only in the Supreme Court and has been long recognized by the Supreme Court's practice in reference to patent causes.

The Act of 1891 creating Circuit Courts of Appeals, Chapter 517, Section 6, 26 Stat. 828, as amended, Section 128 of the Judicial Code, Title 28, U.S.C.A. 225, provides

under Item d the circuits in which reviews shall be had by Circuit Courts of Appeals, *inter alia*, decisions of a District Court of the United States within a State in the circuit embracing such State. Circuit Courts of Appeals were specified respectively for the District Court of Alaska or any division thereof; The Supreme Court of Hawaii, the United States Court for China, the Courts of Porto Rico, of the Virgin Islands, and the Canal Zone.

The appellate jurisdiction of a Circuit Court of Appeals is of course wholly statutory. The intention of Congress is apparently to define and limit the territorial jurisdiction of each Circuit Court of Appeals, to reviews of judgments and decrees of District Courts in that circuit. If there had been any intention to make any right determined in one circuit applicable to all circuits, save for the interposition of the doctrine of *res adjudicata*, Congress would have said so. No exception is made as to patent rights, and there is nothing to indicate that this is in a different class from any other rights on which court adjudications may be had. The disclaimer statutes were apparently designed to care for those patents or contracts that had within them sound, as well as unsound, subject matter. This idea is not new. In the law of contracts, generally, the rule had been long established that where an illegal part thereof was so wrapped up in the contract that it could not be segregated it tainted the entire instrument, but where the illegal part could be segregated it did not invalidate the valid part (*N. Y. C. R. Co.* v. *Gray*, 239 U. S. 583; *U. S.* v. *Mora*, 97 U. S. 413; *U. S.* v. *Bradley*, 10 Pet. 343, 9 L. Ed. 448 (1836); *Gelyscke* v. *Dubuque*, 1 Wall 221 (1863); *Armstrong* v. *Toler*, 11 Wheat. 258 (1826). The same principle has been applied in the case of wills (*Trustees of Phila. Baptist* v. *Hart*, 4 Wheat. 1; *Dahlgren* v. *Pierce*, 270 Fed. 507, (Appeal dismissed 256 U. S. 682,

Certiorari denied, 256 U. S. 692), and in the case of deeds (*McGuire* v. *Van Pelt,* 55 Ala. 344; *Thompson* v. *Marshall,* 36 Ala. 504; *Clark* v. *Hoover,* 51 Tex. Cir. App. 181).

Apparently the disclaimer statute was a mere application of these principles to patents. It was not intended to put upon anyone the duty of disclaiming in a case where the question as to validity went to the entire instrument; and if this be so, then there could be no application of it to a case where the whole or a substantial part of the instrument is found invalid. It is not a case where the old doctrine of invalid in part, invalid *in toto* is to be applied with the remedy against a situation which had been obtained by judicial construction in respect to other instruments, as above pointed out. And so we have a situation in which, quite regardless of the disclaimer statutes, the patent in one action is found invalid. There is no duty upon the owner of a patent to do anything about it. He brings another suit within a short time or within a long time. Length of time is quite immaterial. In respect to his first suit he is barred, as far as the defendant in that suit is concerned, by the well established principle of *res adjudicata.* But the doctrine of *res adjudicata* cannot be transferred for another's benefit. It is true that there are principles not determinative of necessity that are at times applied by way of example under such doctrines as *stare decisis* and under rules of comity where, however, there is no duty imposed upon the tribunal.

Congress did not intend (there is nothing whatever to indicate that it did so intend) to take from the courts of one circuit the power to make its own determination; or to take from the court in a particular circuit power even to change its mind in other litigation on the same subject matter; or to change its mind in other litigation upon the same subject matter generally but with a differ-

ent record. Whatever the power of Congress may be to provide that if a patent adjudicated in a court of last resort in reference to one circuit shall be determinative and binding upon all other circuits, or whatever the power of Congress to declare that a patent adjudicated in any court in any suit shall be a final adjudication of that patent in the same circuit as against all other litigants, it is plain that it has never been exercised. Such a power if exercised would doubtless in fairness have provided that a patent found valid in one circuit could never again have its validity challenged in any other circuit.

Congress in 1925 made changes in the jurisdiction of Circuit Courts of Appeals and of the Supreme Court. It eliminated all rights of appeal that had theretofore existed and abolished writs of error and made every determination in Circuit Courts of Appeals final, save for the relief that might be granted upon the issuance of the writ of certiorari of the Supreme Court. If Congress then had any idea of making the determinations of any Circuit Court of Appeals final as to all circuits and of imposing on any circuit a duty to disregard activities in respect to a given subject matter in other jurisdictions, they would have again said so. Congress promulgated no such procedure.

There can be no finality to the ruling of a Circuit Court of Appeals in one circuit binding upon other circuits—persuasive possibly, but not binding. The rule is no different in patent infringement cases than in other cases.

Appellant herein had a perfect right after the entire substance of its patent had been invalidated to seek to have its patent adjudicated in another circuit. If criticism be directed to the failure of appellant to file a petition for the writ of certiorari in the cases first adjudicated in the Seventh Circuit, the *Macomb* case and the *Monarch* case, appellant's position is that having been advised by this

Court in Rule 38 of its Revised Rules of the circumstances under which such writs would be granted in an endeavor of the court to prevent an over-plus of petitions of this sort Appellant's cases in the Seventh Circuit did not come within it and could not come within it until diversity of opinion between circuits was established. When the situation first arose, Appellant took the only possible action, even though possibly unprecedented, as hereinbefore suggested, which was to endeavor to secure the writ by petition to the Sixth Circuit in the *Bowman* case.

Differences of opinion in relation to the validity of the patent herein exist between Circuit Courts of Appeals. Any doctrine which invokes the disclaimer statutes as a bar in this proceeding and which does not give heed to Appellant's successful efforts in the Sixth Circuit case as tolling the time would be quite contrary to the practice contemplated by this court in suggesting that the court under proper circumstances would consider petitions for the writ of certiorari to promulgate uniformity of decisions between circuits.

Point IV.

A valid disclaimer cannot be made to eliminate elements of a patent for a combination.

It has properly been held that a disclaimer cannot properly apply to a patent claim for a combination so as to eliminate one or more elements of the combination.

Vance v. *Campbell*, 66 U. S. (1 Black) 427.
Gill v. *Wells*, 89 U. S. (22 Wall.) 1.

Obviously the result of such a disclaimer would be to leave the claim for a lesser number of elements in com-

bination, broader and not narrower. Under the statute the patentee is only permitted to disclaim when he has claimed more than he had a right to claim.

The claims in the patent involved herein are for a number of elements in various combinations.

CONCLUSION.

The Certified Questions.

Contemplating that the Court's opinion herein will definitely decide the problem herein presented in all its realties, Appellant's position as to the first certified question is, that the patent owner may, without disclaimer, again sue in the same judicial circuit, or any judicial circuit, on a different record if the claims held invalid covered all the material or substantial part of the thing patented (as they did herein), particularly in view of the institution, pendency, and prosecution of other suit or suits in another judicial circuit or circuits during and after entry of the final decree in the first suit based on claims held invalid and on others not previously adjudicated, and in view of the termination of such proceedings in the other Circuit Court of Appeals in a decree of validity and infringement.

As to Certified Question 2—Continuity of prompt effort in another forum, regardless of the actual time consumed in the pendency, trial and appeal of pending cases, so explains elapsed time, that the particular circumstances of each case must be considered in determining what is a reasonable time.

Appellant urges therefore, that the intervention of approximately five years time between final judgment in the

first suit and the institution in the same circuit of the second suit, did not constitute delay so unreasonable as to bar the second suit for want of disclaimer, since during the interim the Appellant was prosecuting another suit on the same patent in another Circuit Court of Appeals, and in endeavoring to have the diversity of opinion and decision between the Circuits so occasioned, reviewed by the United States Supreme Court.

In Appellant's view hereof, an answer to Question 3 is hereinabove provided in the answers to the previous questions.

Respectfully submitted,

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HEAT INSULATED RECEPTACLE.

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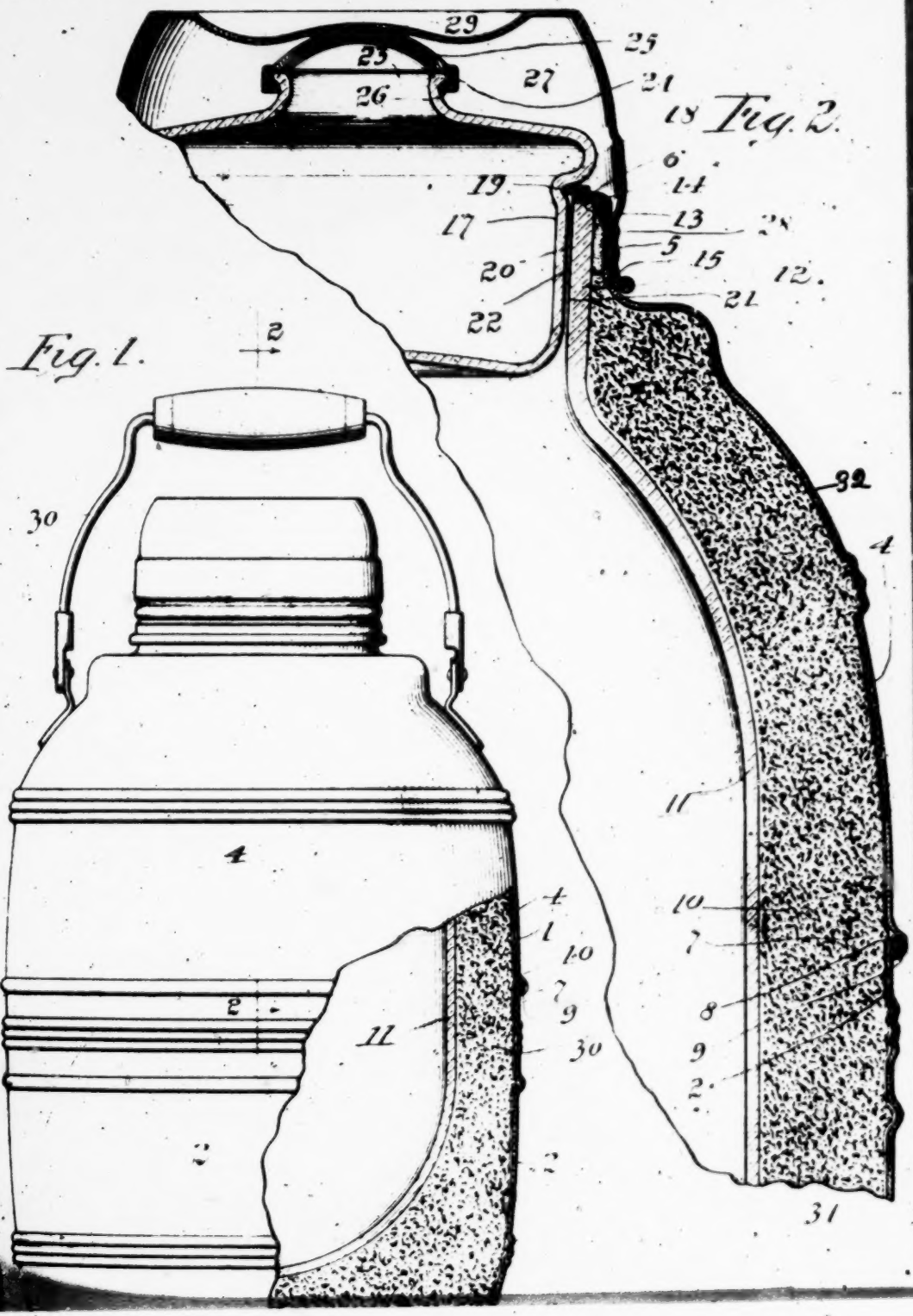
1,435,199. Patented Nov. 14, 1922.



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